

Application No. 09/678,902
Amendment Filed February 26, 2004
In Response to September 26, 2003 Office Action
Request for Continued Examination
Docket No. 6208-9

REMARKS

Applicant has amended claims 32-34 to correct typographical errors, and claims 1, 12, 18, and 29 to further clarify aspects of the current invention as detailed below. Claims 1-4, 8-21, and 25-34 are now pending in this application.

In the Office Action dated September 26, 2003, the Examiner rejected claims 1-4, 8-21, and 25-34 under 35 U.S.C. § 103(a) as being unpatentable over Marshall (U.S. Patent No. 5,774,878) in view of SmartMoney.com ("SmartMoney") and further in view of Datek Online supported by an article from PRNewsWire "Streamer Free Real-Time Stock Quote Service Registers 12,000 Users" ("Datek"). The Examiner also objected to claims 32-34 as referring to methods instead of systems.

The undersigned has reviewed the September 26, 2003 Office Action and respectfully traverses all rejections for the reasons set forth herein.

Claims 1, 12, 18, and 29 have been amended to further clarify that each sector, within the one or more financial indicators which are mapped according to the present invention, is sized relative to its weighting within the corresponding financial indicator. Claims 32-34 have been amended to clarify that claims 32-34 refer to the systems of claims 18, 25, and 28, respectively.

Applicant respectfully submits that no new matter has been added, that the amendment has been made in good faith and that claims 1-4, 8-21, and 25-34 are in proper form for allowance. The undersigned respectfully requests that all pending claims be allowed.

A. Overview

Prior to discussion of the merits of the rejections, a brief description of the invention may be helpful. The present invention relates to a method and system for graphically presenting financial information. Specifically, the invention presents a method and system for displaying on a map of one or more geographic regions, the status of one or more financial indicators which each represent financial activity in one or more particular geographic regions, and contain a

Application No. 09/678,902
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Docket No. 6208-9

plurality of sectors which each contain a plurality of financial instruments. The display simultaneously presents the status of the (1) one or more financial indicators, (2) corresponding sectors, and (3) corresponding financial instruments; while sizing each sector within a financial indicator in relation to the weighting each respective sector possesses within the financial indicator. (Specification, p. 10-12.)

B. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 1-4, 8-21, and 25-34 under 35 U.S.C. § 103(a) as being unpatentable over Marshall (U.S. Patent No. 5,774,878) in view of SmartMoney.com (“SmartMoney”) and further in view of Datek Online supported by an article from PRNewsWire “Streamer Free Real-Time Stock Quote Service Registers 12,000 Users” (“Datek”). Applicant respectfully traverses these rejections.

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references’ teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Applicant’s disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the Examiner has not established a case for obviousness because (a) there is no motivation to modify or combine the reference teachings and (b) even if the references were combined, none of the prior art references, alone or in combination, describe or suggest all of the claimed limitations of the present invention. In order to facilitate support for Applicant’s traversal, we will first discuss the cited art and how the

Application No. 09/678,902
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Request for Continued Examination
Docket No. 6208-9

claimed limitations of Applicant's invention can be distinguished over it, and then address the issue of combining references.

CLAIMED LIMITATIONS

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In the following discussion we will examine each of the cited references and indicate how the pending claim limitations are not taught or suggested by the prior art.

Marshall

Marshall discloses a virtual reality world for conveying financial information. The virtual reality world is bounded by three axes which reflect different non-integer parameters, and contains within in a three-dimensional grid, visual indicators such as geometric shapes which indicate the status of particular financial instruments. (See col. 6, lines 14-55; col. 11, lines 33-59.)

Although Marshall discloses displaying the status of a financial instrument in simultaneous relation to an industry group (i.e., sector), country, and another financial instrument (i.e., financial indicator or index) (Claim 20), Marshall does not teach doing so while simultaneously sizing sectors according to their respective weights within a financial indicator. In fact, the three axis construction of Marshall's virtual reality world teaches away from the sector sizing element of the present invention.

Marshall's three axis virtual reality world necessitates that every cubical zone defined within the three dimensional world be defined by straight lines which each lie a consistent perpendicular distance from the corresponding parallel axis. For example, in a virtual reality world having an x-axis referencing countries, a y-axis referencing sectors, and a z-axis referencing financial indices, all sectors in a certain country "A", and included in a particular index "1", would have the same dimensions along the x-axis and z-axis. Similarly, all countries including a certain sector "a" and corresponding to index 1 would have the same dimensions

along the y-axis and z-axis (that of index 1), and all indices corresponding to country A and sector a would have the same dimensions along the x-axis (that of country A) and y-axis (that of sector a).

As such, the virtual reality world cannot freely vary the size and/or shape of sectors in relation to a given country and/or index because each sector's dimensions are constrained by (1) the sector's y-axis dimension in other countries and in relation to other indices, (2) the given country's x-axis dimension in relation to other sectors and indices, and/or (3) the given index's z-axis dimension in relation to other sectors and countries. In contrast, the present invention can freely size and/or shape each and every sector according to their respective weights within a given index, while mapping those sectors according to the country and/or index to which they correspond.

Claims 1 and 18 have been amended to further clarify that each sector is sized according to its weighting within the one or more mapped financial indicators. As such, Marshall clearly lacks the limitations of the present invention.

SmartMoney

Citing Marshall in view of SmartMoney does not diminish the unique aspects of the pending claim limitations. SmartMoney discloses a graphical mapping of stocks according to their corresponding industry sectors. The map sizes the stocks and sectors in accordance with their respective market caps, and indicates the status of stocks with color shading. SmartMoney does not map sectors in relation to associated countries or corresponding indices, and as such, does not size sectors (or stocks) relative to their respective weighting in an index. (Pages 17-27.)

In contrast, the present invention simultaneously maps financial instruments, sectors, countries, and indices, and sizes sectors according to their respective weights within an index. Thus, SmartMoney does not contain the limitations of claims 1 and 18 of the present invention.

Application No. 09/678,902
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Docket No. 6208-9

Datek

Citing Marshall in view of SmartMoney and further in view of Datek also does not diminish the unique aspects of the claimed invention. Datek discloses a real-time streaming of numerical stock quote information. Datek does not graphically map the financial information. (Page 1.) In contrast, the present invention graphically displays financial information via a map. Thus, Datek does not contain the limitations of claims 1 and 18 of the present invention.

Applicant respectfully submits that Marshall, alone or in view of SmartMoney and Datek, does not describe or suggest the claimed invention and therefore does not provide proper grounds for rejection. The Manual of Patent Examining Procedure (MPEP) states that a ground for rejection "must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal" (MPEP § 706.07). As required by MPEP § 707.07(d), when rejecting a claim for lack of novelty, the Examiner must fully and clearly state the grounds of rejection.

What would be necessary to support a rejection of currently pending claims 1-4, 8-21, and 25-34 under 35 U.S.C. 103(a) is one or more references that describe or suggest a computer-implemented method and computer system that incorporate the unique aspects of the present invention described above. Marshall clearly does not provide such a description or suggestion, either alone or in combination with SmartMoney and Datek.

COMBINATION OF REFERENCES

Even if Marshall, SmartMoney and Datek included a description of each of the claimed limitations, which they clearly do not, Applicant respectfully submits that there is no motivation for someone of ordinary skill in the art to combine the cited references. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts." In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). None of these three possible sources have been demonstrated in the Office Action dated September 26, 2003.

Application No. 09/678,902
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The only grounds offered by the Examiner for combining the cited references is “it would have been obvious to one of ordinary skill in the art at the time the invention was made[.]” (See, e.g., Office Action of September 26, 2003, p. 9-10.) A blanket statement concerning “one with ordinary skill in the art” is a highly subjective and unsubstantiated statement that does not meet the Examiner’s obligation to succinctly establish a prima facie case of obviousness.

Additionally, the Federal Circuit has held that it is inappropriate to rely solely on ‘common sense’ or ‘basic knowledge’ in the art as the principal evidentiary basis for a rejection, without evidentiary support in the record. MPEP § 2144.03(B) (*citing In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2002) (“holding that general conclusions concerning what is ‘basic knowledge’ or ‘common sense’ to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection.”)). Thus, the Examiner has not provided sufficient support for his statement that a “pie chart is a type of chart that businesses use to identify different instruments with their size of the pie (geographical map) proportional their value in the whole pie [sic]” (Office Action of September 26, 2003, p. 9) because he has not shown evidentiary support for his assertion that businesses map financial instruments according to the instruments’ geographical and industrial characteristics.

Thus, Applicant respectfully submits that it would not have been obvious to combine either of Marshall – a virtual reality rendering of financial information -- or SmartMoney – a sector map of stock information – with Datek – a real-time numerical stock quote streamer.

For the same reasons that Marshall, SmartMoney, and Datek, either alone or in combination, fail to disclose the limitations of independent claims 1 and 18, they lack the limitations of dependent claims 2-4, 8-17, 19-21, and 25-34.

Application No. 09/678,902
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Docket No. 6208-9

CONCLUSION

For the reasons set forth above, allowance of this application, as amended, is courteously urged. If there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned at (212) 878-3289 in order for the undersigned to arrange for an interview with the Examiner.

Respectfully submitted,

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Joseph P. Kincart
Reg. No. 43,716

Clifford Chance US LLP
200 Park Avenue
New York, NY 10166-0153
Telephone: (212) 878-3289